

title and to the Examiner's suggested title. Examiner suggested title is believed to be inaccurate. The rebates do not come from the donors but come from the merchants. Accordingly, Applicant has submitted the title, "Method and System For Providing Rebates From Merchants to Organizations." In view of the above, it is respectfully requested this objection be withdrawn.

With respect to the Abstract, it is submitted that the words, "payers" and "payees" are both supported in the specification in the sense that these words are equivalent to "supporters" and "merchants" mentioned in the specification. The supporters pay and are "payers". The merchants receive payment and are "payees". There is no requirement that the language in the abstract is limited to the exact wording of the specification. The meanings are clear. Nevertheless, Applicant has amended the Abstract to change, "payers" to, "supporters" and, "payees" to, "merchants". Thus, it is respectfully requested that this objection be withdrawn.

The Examiner states that Applicant's arguments with respect to claims 1 to 7 have been considered but are moot in view of the new grounds of rejection. He further states that, "indeed, claims 2 to 7 represent new claims that are **not yet examined.**" (emphasis added). Reconsideration of this point is respectfully requested. It is also respectfully requested that the present Final Action be withdrawn and a full action on claims 2 to 7 be given. The Examiner admits that claims 2 to 7 are not yet examined.

Reconsideration is respectfully requested of the objection to claims 2 to 6 and the rejection of claims 2 to 6 under 35 USC 132 as introducing new matter to the disclosure. The Examiner alleges that the original disclosure does not support subject matter in

claims 2 to 6, namely, "recording assigned identification to payers, payees and organizations affiliated with the payers and payees during transactions between the payers and payees". Applicant cannot agree. This subject matter is supported in Fig. 3, element 120, and described in the specification at page 7, 3rd paragraph, lines 2 to 5 which read, "After selecting a PIN, the computer CC, in step 120 assigns the supporter an account number that will be used as the ID when the supporter purchases goods or services at the store. The ID account number will be the number on their transaction card TC." The recording appears in Fig. 3, step 165 as, "Transaction History: Supporter Account Number 4567 Non-Profit Number: 9876".

It is clear from the context of the claims and the specification that the payers are supporters and that the payees are merchants. While the term, "payers" and, "payees" do not appear in the specification per se, there is no requirement that the claims use the exact terminology of the specification. Nevertheless, Applicant has amended the claims to substitute, "supporters" for "payers", and "merchant" for "payees".

The Examiner further alleges that in claim 7, "maintaining a schedule of rebates due from each of organizations from each of the merchants," is not supported by the specification. This subject matter appears in Fig. 3, step 165 which shows the rebates earned; in step 265 of Fig. 4, which shows rebates earned and balance due; and step 365 in Fig. 5, which shows rebates earned, rebate payment, and rebate owed. These are described in the specification on page 8 paragraph 4, page 10 paragraph 4, and page 12 paragraph 4.

Claims 2 to 7 originally referred to "payers" and "payees". Applicant has

changed this language to "supporters" and "merchants" to conform that to the specification. However, it was clearly evident that the "payers" corresponded to the "supporters" and that the "payees" corresponded to the "merchants". Accordingly, it is respectfully requested that this rejection be withdrawn.

Reconsideration is respectfully request of the rejection of claim 1 under 35 USC 103 as unpatentable over Burke 5,621,640. Claim 1 is believed to be distinct and non-obvious from any of the references, alone or in combination, by virtue of "having the central clearinghouse report all transaction to the merchant for having **the merchant forward a rebate to the nonprofit organization**; having the clearinghouse send the nonprofit organization reports as to the amount of spending completed by the supporters at the merchant."

Claim 2 is believed to be distinct and non-obvious from any of the references, alone or in combination, by virtue of, "calculating and recording predetermined rebates to the organization from affiliated merchants in each of the transactions; and transmitting a calculation of accumulated rebates to the merchants and the affiliated organizations **for payment of the rebates by the merchants to the affiliated organization.**"

The dependent claims are believed more specifically to be distinct and non-obvious from any of the references, alone or in combination, by virtue of recording assigned identification is performed at a remote terminal of a merchant; and the steps of associating, calculating, and transmitting are performed in a central clearinghouse as in claim 3; the supporters shop at the merchants, and the merchants agree to rebates to the

nonprofit body as in claim 4; the assignment of identifications as in claim 5; the uploading step and the downloading of accumulated rebates to the remote terminals at the merchants as in claim 6.

Claim 7 is believed to be distinct and non-obvious from any of the references, alone or in combination, by virtue of, **"calculating the rebates due from each merchant to each organization; and transmitting to the merchants, the amount of rebates due from each of the merchants."**

These features offer an orderly and efficient system that eliminates the need for merchants to print and store vouchers and for non-profit organizations to purchase vouchers and resell them to supporters and for supporters to pre-pay in advance for commodities like goods and/or services. According to the aforementioned features, **the rebates come from the merchants and go to the organizations.**

None of the references, alone or in combination, suggests these features nor in any sense makes the claimed method or system obvious. According to the claims, the rebates arise from the merchant and go to the organization.

In the Burke reference, the customer, or payer, corresponding to the supporter, determines the amount which is to go to the charity or other organization. The amount need not be based upon any purchases. There is nothing in Burke which suggests payment due from the merchant to the organization.

The Examiner attempts to apply the language of the claims to the Burke patent, but is unsuccessful or inaccurate in this regard. The Burke reference fails to suggest having the central clearing house report all transactions to the merchant for having

merchant forward a rebate to the non-profit organization. In Burke, the amount determined by the payer (supporter) goes directly to the organization. The merchant makes no rebate to the organization, it is entirely the payer/supporter's money.

The Examiner admits that the Burke reference does not disclose reporting all transactions to a merchant for having the merchant forward a rebate to a non-profit organization and sending reports to the non-profit organization as to the amount of money spent by supporters or donors at the merchant's store. This is a critical difference between the present invention and the Burke reference. In the present invention the money is due from the merchant to the organization. It is the merchant that is giving the rebate to the organization. It is the merchant's money. In Burke, it is the customer's money which goes to the organization, and indeed may remain the customer's money if it is destined for a bank. The Examiner spends a page and a half in a convoluted explanation, but the explanation never even recognizes the distinction, that in one case it is the donor's money and in the other case it is the merchant's money.

Moreover, it is well established that for a reference to make subject matter obvious it must suggest it. As set forth in *In Re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000):

"Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art

reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)."

In view of the above, it is respectfully requested that the claims be allowed and the case pass to issue.

Respectfully submitted,



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CLAIMS WITH MARKINGS TO SHOW CHANGES MADE

What is claimed is:

I. In a system having a clearinghouse component, a nonprofit component, a supporter component, and a merchant component, with the clearinghouse component connecting the other three components via a variety of entry terminals, a method comprising:

providing each of a plurality of supporters with an individual identification number (ID);

entering the ID into an entry terminal;

entering an amount spent by a supporter at a merchant in a transaction;

having the entry terminal record the ID, as well as the amount of dollars spent in a transaction;

uploading the ID and the amount entered to a central clearinghouse;

having the central clearinghouse report all transaction to the merchant for having the merchant send forward a rebate to the nonprofit organization;

having the clearinghouse send the nonprofit organization reports as to the amount of spending completed by the supporters at the merchant.

2. A method of accumulating credits for organizations, comprising:

recording assigned identifications to ~~payers, payees, supporters, merchants~~ and organizations affiliated with the ~~payers and payees~~ supporters and merchants during transactions between ~~payers and payees~~ supporters and merchants;

associating the identification of each ~~payer and payee~~ supporter and merchant with an affiliated organization in response to each transaction;

calculating and recording predetermined rebates to the organization from affiliated ~~payees~~ merchants in each of the transactions; and

transmitting a calculation of accumulated rebates to the ~~payees~~ merchants and the affiliated organizations for payment of the rebates by the ~~payees~~ merchants to the affiliated organization.

3. A method as in claim 2, wherein the steps of recording assigned identification are ~~is~~ performed at a remote terminal of a ~~payer~~ merchant; and



the steps of associating, calculating, and transmitting are performed in a central clearinghouse.

4. A method as in claim 2, wherein the organization is a nonprofit body, the ~~payers are supporters of the nonprofit body, and the payers are sustainers of the nonprofit body~~supporters shop at the merchants, and the merchants agree to rebates to the nonprofit body.

5. A method as in claim 2, further comprising assigning identifications to each of said ~~payers, payees, supporters, merchants,~~ and organizations.

6. A method as in claim 3, wherein each the step of recording includes uploading each transaction to said clearinghouse and the step of transmitting includes downloading accumulated rebates to said the remote terminals at said ~~payees-merchants.~~

7. A program residing in a computer of a central clearinghouse, comprising instructions for performing the steps of:

assigning to organizations and affiliated supporters and merchants individual identifications;

maintaining a schedule of rebates due from the each of the organizations from each of the merchants;

collecting from the merchant, during a transaction between a supporter and a merchant, the identifications of the supporter and the merchant;

calculating the rebates due from each merchant to each organization; and

transmitting, to the merchants, the amount of rebates due from each of the merchants.